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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,644	09/08/2003	Rudolf J. Dams	57952US002	2822
32692 7590 01/16/2007 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER SERGENT, RABON A	
			ART UNIT	PAPER NUMBER
			1711	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/16/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/657,644

Applicant(s)

DAMS ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See paragraph 2</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The Election of Species requirement has been withdrawn.
2. The Information Disclosure Statements filed 12/18/2003, 2/5/2004, 5/21/2004, 12/17/2004, 2/4/2005, 2/17/2005, 6/16/2005, and 6/29/2005 have been considered. Initialed copies of the PTO-1449's are enclosed with this action.
3. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have claimed that T, T', and T'' each independently represent -NCO or an isocyanate reactive group, wherein at least one of T or T'' is -NCO; therefore, T, T' and T'' may all be -NCO groups, since there is no requirement that any of the T variables be isocyanate reactive. Therefore, where all T variables are -NCO groups, it is unclear how a reaction product of (i) and (ii) can result, since there are no isocyanate reactive groups for the isocyanate groups to react with.

With respect to the definition of k' within claims 1, 18, and 22, the use of "about" in association with the integer value of 5 renders the claims indefinite, because it cannot be determined exactly what values are encompassed by the range. In other words, it is unclear exactly what integer value is encompassed by "about 5".

With respect to claim 5, applicants have failed to specify a basis for the claimed weight percent value. It is unclear if the weight percent is based on the weight of the composition or solvent or some other entity.

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With respect to claim 17, the language, "... does not significantly reduce ...", renders the claim indefinite, because no quantitative value can be ascribed to the language. It cannot be determined what constitutes a "significant reduction".

With respect to claim 18, applicants have claimed a mixture within line 1 of the claim; however, only a single component, (a), is recited.

4. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants have failed to provide enablement for the production of reaction products where the fluorinated polyether compound and the silane compound have only isocyanate functional groups, yet applicants' claims provide for this permutation. Furthermore, applicants' claims encompass fluorinated polyether compounds wherein T and T' are defined in such a manner that one compound may contain an isocyanate group and an isocyanate-reactive group; however, applicants have failed to provide enablement for the use of such a compound. Absent guidance concerning how such compounds could be used and such reaction products could be produced, one of ordinary skill in the art would be unable to practice the invention without resorting to undue experimentation. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/729,073. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed subject matter is encompassed by the copending claims.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 2, and 5-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Moore et al. ('272).

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The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Moore et al. disclose fluorinated polyether silane compositions and their application to substrates, such as ceramics and glass. Moore et al. further disclose that the fluorinated polyether silanes may be produced by reacting isocyanate reactive perfluorinated compounds that correspond to applicants' claimed fluorinated polyether compound with isocyanate functional silane compounds that correspond to applicants' claimed silane compound. The reference further teaches that solvents, including fluorinated solvents, are utilized within the compositions. See abstract; columns 3-5; column 11, lines 13+; and Example B within column 13.

9. Claims 1, 2, and 5-23 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/30848.

The reference discloses fluorinated polyether silane compositions and their application to such substrates as ceramics and glass. The reference further discloses that the fluorinated polyether silanes may be produced by reacting isocyanate reactive perfluorinated compounds that correspond to applicants' claimed fluorinated polyether compound with isocyanate functional silane compounds that correspond to applicants' claimed silane compound. The

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reference further teaches that fluorinated solvents may be utilized within the compositions. See pages 4-9 and 11, and especially examples B and D within page 12.

10. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al. ('272) or WO 02/30848, each in view of Brown ('624) or Scicchitano et al. (US 2002/0016267) or WO 01/34670.

As aforementioned within paragraphs 8 and 9, the primary references disclose solvent containing fluorinated polyether silane compositions which are considered to meet those claimed; however, the primary references are silent with respect to the incorporation of surfactants or fluorosurfactants into the composition. However, the use of surfactants, such as fluorosurfactants, within fluorinated coating compositions was well known at the time of invention. This position is supported by the teachings of Brown at column 19, lines 5-7, Scicchitano et al. at paragraph [0081], and WO 01/34670 at page 9, lines 16+. Since it has been held that it is *prima facie* obvious to use a known compound for its art recognized purpose, the position is taken that it would have been obvious to utilize the claimed fluorosurfactants in their art recognized capacity as additives for fluorinated coating compositions, so as to arrive at the instant invention. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.

Any inquiry concerning this communication should be directed to R. Sargent at telephone number (571) 272-1079.

R. Sargent
January 6, 2007


RABON SERGENT
PRIMARY EXAMINER